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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/805,864

03/22/2004

Gary M. Johnson

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APPLIED MEDICAL RESOURCES CORPORATION

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EXAMINER

HALL, DEANNA K

ART UNIT

PAPER NUMBER

3767

MAIL DATE

DELIVERY MODE

05/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/805,864	Applicant(s) JOHNSON ET AL.	
	Examiner DEANNA K. HALL	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22, 25, 26 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) 5, 7, 14, 15, 17-22 and 36-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-13, 16, 25, 26 and 40-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 30, 2009 has been entered.

Acknowledgments

2. This office action is in response to the reply received April 30, 2009.
3. In the reply, the applicant added new claims 45-50.
4. Claims 1-4, 6, 8-13, 16, 25-26 and 40-44 will be examined in this action.

Election/Restrictions

5. Newly submitted claims 45-50 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: An element of newly added claim 45 is a "retention member" which is an non-elected element (claim 5) drawn to a different species of the restriction requirement of January 10, 2008.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

prosecution on the merits. Accordingly, claims 45-50 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1, 3, 8, 40-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Popov et al. (US 7,422,572) (“Popov”).** Popov discloses a surgical access port comprising:

An elongate tubular body 8 having a lumen 10 and a tissue penetrating tip 31 connected to and disposed at the distal end of the tubular body capable of penetrating through a body wall; the tip in a first, penetrating position blocks the lumen of the elongate body and the tip is capable of swinging from the first penetrating position to a second, retaining position to unblock the lumen of the elongate body, see Figs. 8-9.

The tip of Popov is sharp pointed or bladed, Fig. 9.

The tip of Popov is capable of repositioning to one side of the tubular body when no axial load is present.

The tip of Popov is capable of being a non-expanding tip or a non-compressible tip. The tip is a single-piece tip, Fig. 3.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 4, 6, 9-13, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popov in view of Roth (US 5,626,598).

Popov discloses the invention as substantially claimed (see above). However, Popov does not directly disclose the tip of the tubular body being substantially blunt or conical. Roth, in the analogous art, teaches a trocar assembly with a tip capable of having several configurations including blunt or conical, see Figs. 8, 10, 12, 14, 16, 18, 20. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the device of Popov with the blunt or conical tip of Roth for entering the body tissue with a reduced penetration force. The tip of Roth further teaches a conical, tapered or rounded shape capable of separating tissue layers, Fig. 20.

The tip of Popov further is capable of remaining in an off-axis condition until removal of the access port whereby it is then capable of realigning with the axis of the

tubular body. The repositioned tip of Popov is capable of remaining in a substantially right-angled condition.

Further, wherein Popov discloses a surgical instrument (needle 2) enclosed in the tubular body 8, Popov does not directly disclose a port with an opening sealed by a seal housing and opened into the tubular body to allow passage of surgical instruments. Roth, in the analogous art also teaches this feature C6 L30-34, obturator of Roth.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Popov.

Popov discloses a tubular body 8 having a tip 31. Popov does not address the materials used to form the tubular body or the tip. Applicant has not disclosed that having at least one of the tubular body and tip formed from an optically clear material solves any stated problem or is for any particular purpose. Moreover, it appears that the tubular body and tip of Popov, or applicant's invention, would perform equally well with the tubular body and tip being formed from any material.

Accordingly, it would have been prima facie obvious to a person having ordinary skill in the art at the time the invention was made to have modified Popov such that at least one of the tubular body and tip is formed from an optically clear material because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Popov.

Response to Arguments

11. Applicant's arguments have been fully considered but they are not persuasive. In response to applicant's argument that "Popov does not disclose the lid 31 is a tissue penetrating tip", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, the lid 31 is capable of penetrating through a body wall and into the body cavity.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEANNA K. HALL whose telephone number is (571)272-2819. The examiner can normally be reached on M-F 9:00am-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deanna K. Hall/
Examiner, Art Unit 3767
5/7/09
/Kevin C. Sirmons/
Supervisory Patent Examiner, Art Unit 3767